

**REMARKS**

Claims 39, 42-51 and 53-61 are currently pending in the application. Applicant has amended claims 39 and 53. Applicant requests reconsideration of the application in light of the following remarks.

**Rejections under 35 U.S.C. §112**

Claims 39, 42-51 and 53-61 stand rejected by the Examiner under the first paragraph of 35 U.S.C. 112. The Examiner has indicated in the Office Action that claim 39 “contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.” Applicant respectfully traverses this rejection and requests reconsideration of the claims.

As currently amended, claim 39 recites “generating an indication of when a patient’s requested appointment should be scheduled, after the patient has been accepted as a new patient.” The specification clearly describes a way to enable one to make and/or use the invention, particularly on page 37, line 13 to page 38, line 18 of the specification. This portion of the specification describes the types of indicators and how those indicators provide for an indication of when to schedule an appointment. The indication of when to schedule an appointment, as found on page 38, may include 1) as soon as possible, 2) no sooner than one week away and 3) no sooner than one month away for example. In accordance with this rejection, the independent base claim 39 has been amended and all claims are now believed to conform with the first paragraph of Section 112. Applicant respectfully requests that the rejection of claims 39, 42-51 and 53-61 under the first paragraph of 35 U.S.C. § 112 be withdrawn.

Claims 39, 42-51 and 53-61 stand rejected by the Examiner under the second paragraph of 35 U.S.C. 112. The Examiner has indicated in the Office Action with respect to claim 39 that a “claim reciting an apparatus and a method of using that apparatus renders the claim indefinite because it does not apprise a person of ordinary skill in the art of its scope.” Applicant respectfully traverses this rejection and requests reconsideration of the claims.

As currently amended, claim 39 recites “a processor operating in accordance with software for: . . . receiving an identifier. . .; accessing data . . .; generating an indication of the net present value . . .; and generating an indication of when a patient’s requested appointment should be scheduled after the patient is accepted as a new patient.” The language of the claim apprises one of ordinary skill in the art that the scope of the system includes a processor having particular functionality including “receiving an identifier. . .; accessing data . . .; generating an indication of the net present value . . .; and generating an indication. . .” Claim 39 recites a system and a particular functionality of a component of the system that further serves to define the scope of the invention. In accordance with this rejection, the independent base claim 39 has been amended and all claims are now believed to conform with the first paragraph of Section 112. Applicant respectfully requests that the rejection of claims 39, 42-51 and 53-61 under the second paragraph of 35 U.S.C. § 112 be withdrawn.

### **Rejections under 35 U.S.C. §103**

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest

all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based upon the Applicant's disclosure. A failure to meet any one of these criteria is a failure to establish a *prima facie* case of obviousness. MPEP §2143.

### **Claims 3, 42-51 and 53-61**

Claims 39, 42-51 and 53-61 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Keyes et al. (U.S. Patent No. 6,456,983, hereinafter "Keyes"), in view of Jones (U.S. Patent No. 6,044,351, hereinafter "Jones") and Evans (U.S. Patent No. 5,924,074, hereinafter "Evans"). Applicant respectfully traverses this rejection and requests reconsideration of the claims.

#### **The Claims are Not Obvious**

The combination of Keyes, Jones and Evans referred to by the Examiner fails to provide a *prima facie* showing of obviousness as required by §2143 of the Manual of Patent Examining Procedure (MPEP). Three criteria must be met to provide *prima facie* obviousness. The first of these is a suggestion or motivation in the references or the knowledge generally available to combine the reference teachings. The second is that a reasonable expectation of success must exist from the references should the combination be carried out. The third is that the prior art must teach or suggest all of the claim limitations. Applicant submits that all of these elements are lacking in the Examiner's rejection.

##### **A. No Motivation or Suggestion to Combine the References**

When applying 35 U.S.C. § 103, the references must be considered as a whole and must suggest the desirability and, thus, the obviousness of making the combination. *Hodash v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143, n. 5, 229 USPQ 182, 187, n. 5 (Fed. Cir. 1986). Applicant further submits that references cannot be considered collectively until the Examiner points to some motivation to combine those references. The purpose behind this

requirement is to prevent the Examiner from using the invention itself and hindsight reconstruction to defeat the patentability of the invention. The Federal Circuit, in a recent decision, articulates this position:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

See *In re Rouffet et al.*, No. 97-1492, 1998 U.S. App. Lexis 16414, at 15-16 (Fed. Cir. July 15, 1998).

The references do not teach the desirability of making the combination. Keyes teaches a system and method for evaluating an offer made in relation to certain delinquent accounts, and more specifically to charge accounts. The system has two components, a historical portfolio module and an evaluation module that is operated by a computer. The historical portfolio module is used to retrieve an appropriate collection of historical data based upon analysis to be conducted on certain currently delinquent accounts, identify a basis for dividing the retrieved collection of historical data into a plurality of groups, and obtain information on the payment history for each group. The evaluation module can then process the information from the historical portfolio and make a recommendation on the disposition of the currently delinquent accounts being analyzed. A NPV is calculated and the preferred system calculates three separate NPV's and compares them to determine the disposition of the delinquent accounts, i.e. whether to accept an offer or not. (See col. 4, line 42 - col. 5, line 10 and col. 9, line 39 - col. 10, line 19).

Jones is a computer software program that predicts the probability distribution of health care facility future minimum income for a total time interval consisting of equal sized

time sub-intervals. This information provides physicians with information to be able to compare costs and worst case scenario future income. (See col. 2, lines 9-30).

Evans is a medical records system that is used to create and maintain patient data electronically. As part of the system health care provider has the ability to schedule an appointment using a point and click interface.

The Office Action asserts that it would be obvious to combine the evaluation of an offer made in relation to delinquent accounts aspects of the Keyes system with the prediction of the probability distribution of health care facility future minimum income aspects of Jones for the “motivation of allowing a physician to predict future health care income to plan for the ‘worst case’ scenario.” *See* Office Action, p. 5. The Office Action further asserts that Evans “discloses enabling a healthcare provider to schedule a patient appointment using a point and click interface by selecting an appointment data and an appointment time, and wherein the healthcare provider can review prior or future scheduled appointments.” The asserted motivation does not provide motivation to combine the Keyes system with the future minimum income aspect of Jones, but rather to combine some other system for determining the worst case scenario or income related to costs.

Additionally, there is no motivation found for one of ordinary skill in the art to combine the future minimum income system of Jones with a disposition of delinquent accounts system like Keyes and further with the appointment scheduling aspect of electronic medical records system of Evans. Systems like Keyes operate on the fact that the consumer has already received a service or valued return for the debt incurred and is determining a relative value of each group of currently delinquent accounts with respect to historical variables. Jones operates on the basic presumption insurance companies will pay its debts according to its payment fee schedule. The value of the future minimum income already assumes that the insurance company will make the payment and therefore one of ordinary skill in the art would not be motivated to combine it with a system that operates specifically with delinquent accounts. Further there is no motivation to even utilize a system for

delinquent accounts wherein the NPV of a group of accounts is generated to determine the disposition of the accounts, such as selling them for an agreed upon price or retaining them within the healthcare industry to determine the NPV of a future medical service dependent upon the payment patterns of a particular third party payor. Additionally, it is not obvious from Evans to generate an indication of when an appointment should be scheduled. Evans simply gives the healthcare provider the ability to schedule appointments using a point and click interface, not the ability to indicate when the most cost effective future date for scheduling an appointment is.

**B. Cited References do not Provide Reasonable Expectation of Success**

The cited references do not provide a reasonable expectation of successful combination or an explanation of how they would be combined to teach or suggest the claimed invention. While the Examiner argues one would be motivated to combine the Keyes disposition of delinquent accounts with the future minimum income of Jones and further with the appointment scheduling of Evans, the Federal Circuit has held that “obvious to experiment” is not the standard for obviousness. *In re Dow Chemical*, 5 USPQ2d 1529 at 1532 (Fed. Cir. 1988). In moving from the prior art to the claimed invention, one cannot base a determination of obviousness on what the skilled person might try or find obvious to try. The proper test requires determining whether the prior art provides an express suggestion to combine with an expectation of success.

The Office Action asserts that the disposition of delinquent accounts should be applied to the prediction of future minimum income process, but does not indicate where in the combined teachings of Keyes and Jones the explanation exists for how to combine the references or that there will be any indication that such a combination will provide a valued service or even be feasible. In the references, there does not appear to be any indication that the use of historical data of a delinquent account can adequately or successfully be combined with the medical health services field to make a determination by use of historical payment data from a third party payer what the value of a future medical service would be.

Additionally, neither Keyes nor Jones disclose what effect, or infer that it may have an effect, late payment, partial payment or non-payment by a third party payer may have on the value of a future medical service to be provided to a patient. Different considerations need to be made in evaluating the likelihood of success for collecting from an insurance company for a future medical service to be provided to a patient according to the insurance company's schedule of fees.

Further, there is no likelihood of success for including the scheduling aspects of Evans with the systems of Keyes and Jones. Particularly there is no likelihood of success that from these three references that a system may be created that allows for the determination of whether to accept a patient dependent in part upon the historical payment data of a third party payor, to determine an NPV and further to generate an indication of when to schedule a new patient, wherein the indication uses among other data, a third party payor's payment pattern and other relevant data to indicate when an appointment should be scheduled.

A person skilled in the art would not be led to combine a system for evaluating an offer made in relation to certain delinquent accounts with a system that predicts the probability distribution of health care facility future minimum income to determine specifically the value likely to be collected from the insurance company based upon their historical payments prior to providing the medical service from the disclosures of Keyes and Jones. Additionally, a person skilled in the art would not be led to combine the systems of Keyes and Jones with the scheduling aspect of Evans. Again, Applicant only discovered the value and possibilities for its system after significant empirical calculations and experimentation, the ultimate results of which are provided in Applicant's specification. Prior to these experiments and the efforts and ingenuity of Applicant, it was impossible to predict whether such a system was viable and whether the process would be valuable to doctors. Therefore, no reasonable expectation of success existed previously.

C. Cited References Do Not Teach the Claim Limitations

Even if the cited references are combined (and Applicant maintains that combination is improper), the cited references do not teach each claim limitation. The teachings of Keyes, Jones and Evans are detailed under section A above. Claim 39 was amended and recites, “a processor operating in accordance with software for: . . . receiving an identifier. . . ; accessing data . . . ; generating an indication of the net present value . . . ; and generating an indication of when a patient’s requested appointment should be scheduled after the patient is accepted as a new patient.”

Keyes, Jones and Evans fail to disclose the limitation of “generating an indication of when a patient’s requested appointment should be scheduled after the patient is accepted as a new patient.” The Office Action asserts that Evans discloses this limitation. Evans discloses the ability for a health care provider to schedule an appointment using a point and click interface. However, Evans does not disclose the ability of the electronic medical records system to generate an indication of when an appointment should be scheduled. It merely gives a healthcare provider the ability to schedule the appointment at a future date using a particular interface.

Because there is no teaching, suggestion or motivation to combine Keyes with Jones and further with Evans, no reasonable expectation of success if they were combined as the Examiner suggests, and not all of the elements of claim 39 are included within the proposed combination of references, claim 39 is allowable over the combination of Keyes, Jones and Evans. Dependent claims 42-51 and 53-61 are each allowable over the combination of Keyes and Jones, among other reasons, for depending from allowable claim 39. Accordingly, Applicant respectfully requests that the obviousness rejection of claims 39, 42-51 and 53-61 be withdrawn.

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Reply of Office action of January 27, 2006

Docket No. SHOL-0587

**Regarding Doctrine of Equivalents**

Applicant hereby declares that any amendments herein that are not specifically made for the purpose of patentability are made for other purposes, such as clarification, and that no such changes shall be construed as limiting the scope of the claims or the application of the Doctrine of Equivalents.

**CONCLUSION**

In summary, and in view of the amendments herein, none of the references cited by the Examiner nor any other known prior art, either alone or in combination, disclose the unique combination of features disclosed in Applicant's claims presently on file. For this reason, allowance of all of Applicant's claims is respectfully solicited.

If any fees, including extension of time fees or additional claims fees, are due as a result of this response, please charge Deposit Account No. 19-0513. This authorization is intended to act as a constructive petition for an extension of time, should an extension of time be needed as a result of this response. The examiner is invited to telephone the undersigned if this would in any way advance the prosecution of this case.

Respectfully submitted,

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By



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